

Application No.: 10/734,936
Docket No.: CL1878 US NA

Page 13

REMARKS

Claims 1 – 30 are in this Application.

Claims 2, 18 and 19 have been previously withdrawn.

Claims 1, 3-17 and 20 -30 are under consideration in response to the current Office Action.

The Examiner has rejected claims 1, 3-17 and 20 -30 under 35 U.S.C. § 112, first paragraph and further objects to claims 1, 11 and 15.

Claims 1, 3, 11, 15, and 17 and have been amended herein to more clearly define Applicant's invention.

The specification has been amended to address the use of trademarks.

Claims 12 and 25 have been additionally canceled by this Response and Amendment.

No new matter has been added.

Specification

The specification is objected to for the improper recitation of trademarks. Trademarks should be capitalized whenever they appear and be accompanied by generic terminology. The specification has been amended to overcome this objection.

Claim Objections

The Examiner objects to claims 3, 11 and 15. Claim 3 is objected to as being grammatically incorrect. In following with the Examiner's suggestion the phrase "second the expressible" has been amended to read "second expressible". The claim is now grammatically correct.

Claims 11 and 15 are both objected to as being dependent on a withdrawn claim. Both claims have been amended to change the multiple dependency to a singular dependency on pending claim 1. Both claims are now in good order.

In view of the foregoing applicant submits that the form of the claims is now in order and respectfully requests that the Examiner withdraw the objections to claims 3, 11 and 5.

Claim Rejections – 35 U.S.C. § 112, second paragraph

Claims 1, 3,-17 and 20-30 are rejected under 35 USC § 112, second paragraph for indefiniteness. Specifically:

A. Claim 1, step (b)(ii) and claim 17 step (b)(ii) are vague of the recitation of "RR3 is a third recombination of"

B. Claims 10 and 24 lack antecedent basis of "the phage" and "the *lac* promoter"

The claims have been amended to overcome these rejections.

Claim Rejections – 35 U.S.C. § 112, first paragraph

Application No.: 10/734,936
Docket No.: CL1878 US NA

Page 14

The Examiner has rejected claims 1, 3-17, and 20 -30 under 35 U.S.C. §, first paragraph maintaining that the Specification is not enabling for all the pending claims. While not intending to agree with the Examiner's reasoning concerning whether the Specification is enabling for species outside *E. coli*, Applicant wishes to traverse the rejection by limiting the claims to *E. coli*. Support for this amendment can be found in the examples of the Specification.

In view of the foregoing, the Applicant submits that the claims are enabled by the Specification. Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 112, first paragraph.

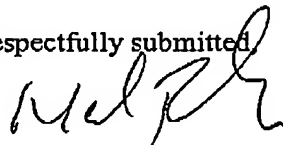
CONCLUSION

In view of the foregoing Amendments and Remarks, Applicant respectfully requests reconsideration of the claims and removal of all objections and rejections.

As cited by Examiner, the closest art in the field is, Perkins and Tugendreich U.S. Patent Application US 202/0151058 and Zhang et al. (1998) Nature Genetics 20: 123-128. Neither publication teaches of the present invention either independently nor in view of the other or in view of any other publication. Further it would not be obvious to one skilled in art to adapt the publication independently, together, or in combination with another publication to practice the present invention. Therefore, the Applicant submits that claims 1, 3 - 11, 13 -17, 20 - 24 and 26 - 30 are in condition for allowance and it is respectfully requested that a patent be issued on these claims.

This response is within the shorten statutory period as set by the Examiner, therefore no fee is believed due at this time. Should there be any fee due in connection with the filing of this Response please charge such fee to Deposit Account No. 04-1928 (E. I. du Pont de Nemours and Company).

Respectfully submitted



S. NEIL FELTHAM
ATTORNEY FOR APPLICANT
Registration No.: 36,506
Telephone: (302) 992-6460
Facsimile: (302) 992-5374

Dated: March 17, 2006